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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

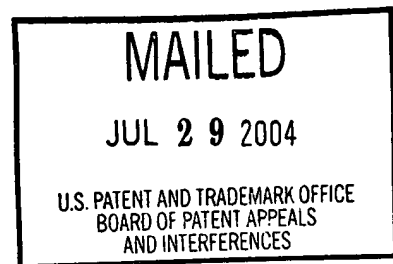
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG METTERNICH, GERALD ARNOLD,
MICHAEL EHRLMANTRAUT and STEFAU AKERBLOM

Appeal No. 2003-0494
Application No. 09/176,012

ON BRIEF



Before JERRY SMITH, BARRETT and NAPPI, Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

Decision on Appeal

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 through 29.

The Invention

The invention relates to a system to allow a person to access information by using the short message service of a phone. A person uses a data processing system to generate a query profile, which contains both a request for the information and the

brief command associated with the request for information. The query profile is communicated and stored at the information provider. A user can then contact the information provider via a mobile phone and use the brief command to access the information requested. This allows the user to make a request and obtain information, without having to use the information provider's predetermined complex commands (see page 3 of appellants' specification)

Claims 1 and 15 are representative of the invention

1. A method for defining and later retrieving user-specified information by means of a mobile telephone, comprising the following steps:
 - a) using a user data processing system to prepare at least one query profile where each query profile has at least one information requirement and an associated brief command and where each brief command can be specified using the keypad of a mobile telephone;
 - b) sending the query profile using the user data-processing system to an information supplier;
 - c) sending an information call using a mobile telephone to the information supplier containing at least one of the brief commands;
 - d) comparing the brief command sent in accordance with step c) with the brief commands of the query profiles prepared and sent in accordance with steps a and b);
 - e) putting together the information of the information requirements contained in the associated query profile in the event of agreement in accordance with step d);
 - f) sending the collected information to the mobile telephone; and

g) presenting the information to a user of the mobile telephone by way of the mobile telephone.

15. A method for producing a user-specified information requirement which can be accessed via SMS messages of a mobile telephone, comprising the following steps:

a) using a user data processing system to prepare a query profile, having an associated brief command and at least one information requirement, where the brief command can be produced using the keypad of a mobile telephone;

b) sending the query profile in accordance with step a) using the user data-processing system to an information supplier; and

c) storing the query profile at the information provider on an information supplier data-processing system which can communicate with a telephone network of the mobile telephone.

References

Sormunen et al. (Sormunen)	6,112,078	Aug. 29, 2000 (filed Feb. 20, 1997)
Honda	5,875,405	Feb. 23, 1999 (filed Dec. 26, 1995)

Rejections at Issue

Claims 15, 16 and 20 stand rejected under 35 U.S.C. § 102 as being unpatentable over Honda¹.

Claims 1, 2, 6, 7, 9 through 12, 14, 21, 23 through 27 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen.

¹ We note that in the final rejection, claim 17 was rejected under 35 U.S.C. § 102. However, claim 17 is not included in the statement of the rejection under 35 U.S.C. § 102, on page 4 of the examiner's answer. As the examiner also rejected claim 17 under 35 U.S.C. § 103, we assume that the examiner withdrew the rejection of claim 17 under 35 U.S.C. § 102, see *Ex Parte Emm* 118 USPQ 180, 181 (BdPatApp&Int, 1958).

Claims 3 through 5, 8, 13, 22 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen and well known prior art.

Claims 17 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of well known prior art.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief² along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra* we reverse the examiner's rejection of claims 1 through 14 and 23 through 29 under 35 U.S.C. § 103. We affirm the examiner's rejection of claims 15, 16 and 20 under 35 U.S.C. § 102 and the examiner's rejection of claims 17 through 19, 21 and 22 under 35 U.S.C. § 103.

Grouping of the Claims

At the outset we, we note that appellants state on page 10 the brief that:

²This decision is based upon the Appeal Brief received May 24, 2002.

It is the position of the applicants that each independent claim in the application, claims 1, 15 and 23, stands on its own merits for consideration of review of the Final Rejection. Except where discussed separately below, dependent claims may be grouped with their respective independent claim.

37 C.F.R. § 1.192(c) (7) (July 1, 2001) as amended at 62 Fed. Reg. 53196

(October 10, 1997), which was controlling at the time of appellant filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and in the argument under paragraph (c) (8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out the differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider the appellants' claims in nine groups. Group A consists of claim 15 and claim 20³ and we will consider claim 15 as representative of that group. Group B consists of claim 16. Group C consists of Claims 17 through 19 and we will consider claim 17 as representative of that group. Group D consists of claim 21. Group E consists of claim 22. Group F consists of claims 1, 2, 6, 7, 9 through 12 and 14 and we will treat claim 1 as a representative claim of that group. Group G consists of claims 23 through 27 and 29 and we will treat claim 23 as a representative claim of that group. Group H consists of claims 3 through 5, 8 and 13 and we will consider claim 3 to be representative of that group, Group I consists of claim 28.

³ We do not consider appellants statement concerning claim 20, on page 15 of the brief, to constitute an argument as to why claim 20 is separately patentable, rather we consider it to be a statement pointing out a difference in what the claims cover. Accordingly, we group claim 20 with claim 15.

We first consider the rejection of claims 15, 16 and 20 under 35 U.S.C. § 102 as being unpatentable over Honda. Appellants' arguments directed to the claims in group A, claims 15 and 20, are on pages 10 through 14 of the brief. Appellants argue on page 11 of the brief that claim 15 differs from the teaching of Honda in that claim 15 includes the limitation of a query profile and that:

the important point being that the query profile does not contain the data to be stored, but only a profile of a query to be performed on data existing on the information provider's system. The distinction also appears in the language of claim 15 itself. The query profile is described as containing "at least one information requirement"- an information requirement is different from the information itself.

While we recognize that the invention disclosed in the appellants' specification is different than the teaching of Honda, it is the claims, which are subject to the rejection. Therefore, before we consider the relevant teachings of the prior art, we must first determine the scope of the claims. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (1996). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'"

(emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.* 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d at 1204, 64 USPQ2d at 1819.

Claim 15 includes the limitation of a “query profile, having an associated brief command and at least one information requirement”. Appellants argue on page 11 of the brief that the implication of claim 15 is that the information is independent of the information requirement and cite examples in the originally filed specification to support this implication. We do not find another limitation in claim 15 that further defines the information requirement or its function. Also, we do not find a limitation in claim 15 that either defines or differentiates information from information requirement. Accordingly,

we do not find that claim 15 contains the implication that the information is independent of the information requirement, as argued by the appellants.

The examiner, on page 2 of the answer, refers to column 4, lines 12-20 of Honda as teaching the query profile. This section of Honda teaches that the abbreviated dialing registration (ADR) data consists of an abbreviated number and an ID number, phone number (see also Honda Column 4, lines 21 to 30). We find that the ADR data meets the claimed query profile and that the abbreviated number and ID number meets the claimed brief command and information requirement. The plain meaning of the term "requirement" is "a thing demanded." Honda teaches that the ID number is what is provided in response to the user pushing a button for the abbreviated number, thus we consider the ID number as the information requirement (the "thing demanded").

Appellants' second argument directed to the claims in group A, rejected 35 U.S.C. § 102 as being unpatentable over Honda, is presented on pages 12 through 14 of the brief. Appellants argue on page 12 of the brief that:

[C]laim 15 requires a "user data processing system" be used to prepare the query profile(s) and to send them to the information supplier. This "user data processing system" is separate and distinct from the user's mobile phone. This is made clear by the fact that steps a) and b) of claim 15 are specified as being performed by the "user data processing system" while step c) is specified as being performed by a mobile telephone.

We do not find this argument convincing. We do not find that step c), of claim 15, is specified as being performed by a mobile telephone. Step c) is a step of "storing the query profile at the information provider on an information supplier data processing

system.” Step c) further states that the system “can communicate with a telephone network of the mobile telephone.” We find that the scope of this limitation does not include using a telephone to perform the method step, but rather that the method step is implemented with an information provider that is capable of communicating with a telephone. Step a) of claim 15 contains a similar limitation, that “the brief command can be produced using the keypad of a mobile phone.”

The examiner states, on page 4 of the answer, that Honda discloses, “using a user data processing system (e.g. MT1) to prepare a query profile”. Appellants argue, on pages 13 and 14 of the brief, that a data processing system is separate from a telephone and contains greater functionality than a phone. We are not convinced by the appellants’ argument. The term “data processor” is not defined in the claims or the specification. The plain meaning of the term is “the handling of information by electronic machine in accordance with strictly defined system procedures.”⁴ This definition is consistent with the appellants’ specification. However, it is broader than either a PC, as suggested by appellants on page 12 of the brief, or a machine with a full function keyboard, as suggested by appellants on page 13 of the brief. Thus, we find the scope of the claim limitation of a data processor in claim 15 is broad enough to encompass an electronic machine for handling information.

In the statement of the rejection, on page 2 of the brief, the examiner equates Honda’s mobile telephone terminal MT1 to the data processing system and the base

⁴ Definition taken from Random House College Dictionary, Revised Edition, 1982.

station to the information supplier. We agree with the examiner's rationale. We find that Honda teaches that the mobile telephone terminal MT1 can operate in several modes. In one mode, MT1 can operate as a mobile telephone the user can enter an abbreviated command that is transmitted to the base station (see column 4, lines 2-9). Thus, Honda teaches limitation c) of claim 15 that the base station can communicate with a mobile phone. In another mode, MT1 can operate as a data entry device in which the user inputs abbreviated commands and corresponding ID numbers to be transferred and stored in the base station (see Column 4, lines 11 to 29). Thus, Honda teaches limitation a) of claim 15 that data processor system is used to prepare a query profile. Accordingly we sustain the examiner's rejection of claims 15 and 20 under 35 U.S.C. § 102 as being unpatentable over Honda.

Group B

We next consider the rejection of claim 16, Group B, under 35 U.S.C. § 102 as being unpatentable over Honda. Appellants state on page 14 of the brief that claim 16 adds the limitation of information being transmitted by a link. Appellants further state that though Honda teaches sending data over a data link, the data is not a query profile and is not sent by a separate data processing system. As stated *supra* we find that Honda teaches the query profile and data processing system limitations of claim 15. Since appellants have not argued a limitation added by dependent claim 16, we sustain the rejection of claim 16 for the same reasons applied *supra* to claim 15.

Group C

We next consider the rejection of claims 17 through 19, Group C, under 35 U.S.C. § 103 as being unpatentable over Honda in view of well known prior art. Appellants have not provided any arguments with respect to this rejection of claim 17. Appellants' arguments on page 14 of the brief directed to the rejection of claim 17 under 35 U.S.C. § 102, focus on the limitation of a "speech computer" not being taught by Honda. This argument is not applicable to the rejection under 35 U.S.C. § 103, as the examiner states, on page 12 of the answer, that "Honda, however, fails to specifically disclose ...a speech computer." Appellants argue this rejection with respect to claims 18 and 19, on page 17 of the brief, stating that by the reasoning provided with respect to claim 15, the rejection of claims 18 and 19 is also improper. As stated *supra* we find that Honda teach the limitations in independent claim 15. Since appellants have not argued a limitation added by dependent claims 17 through 19, we sustain the rejection of claims 17 through 19 for the same reasons applied *supra* to claim 15.

Group D

We next consider the rejection applied to claim 21, group D. Claim 21 is rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen. Claim 21 is ultimately dependent upon independent claim 15, and is thereby grouped separately from the claims dependent upon either claims 1 and 23. Appellants' arguments concerning this rejection are on pages 15 through 17 of the brief and are directed to independent claims 1 and 23. Appellants' argue on page 16 of the

brief, that Honda does not teach a query profile and does not teach the use of a data processing system separate from a mobile telephone. These arguments are not directed at claim 21 and inasmuch as they apply to claim 21 are the same as already addressed with respect to claim 15. As stated *supra* we find that Honda teaches the query profile and data processing system limitations of claim 15. Since applicant has not argued a limitation added by dependent claim 21, we sustain the rejection of claim 21 for the same reasons applied *supra* to claim 15.

Group E

We next consider the rejection applied to claim 22, group E. Claim 22 is rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen and well known prior art. Appellants argue on page 17 of the brief that by the reasoning discussed in reference to independent claim 15, the rejection of claim 22 is improper. As stated *supra* we find that Honda does teach the limitations in independent claim 15. Since applicant has not argued a limitation added by dependent claim 22, we sustain the rejection of claim 22 for the same reasons applied *supra* to claim 15.

Groups F and G

We next consider the rejection of claims 1, 2, 6, 7, 9 through 12, 14, 23 through 27 and 29 (groups F and G) under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen. Appellants argue on page 16 of the brief that the combination of the references does not teach "producing and sending a query profile that is to be used

to retrieve independently- existing information as opposed to producing and sending the information itself.”

We agree. Whereas we do not find this argument convincing with respect to claim 15 because we do not consider the scope of claim 15 to include such a limitation. Claim 1 contains the additional limitations of “putting together the information of the information requirements contained in the associated query profile” and “sending the information to the mobile telephone.” Independent claim 23 contains similar limitations in steps c) and d). Honda teaches that the ID number can be sent from base station to phone and vice versa (see Honda Column 4, lines 10-33). However, Honda does not teach that the ID number (phone number) is used to put together information and that the information is sent to the mobile telephone. Accordingly, we will not sustain the rejection claims 1, 2, 6, 7, 9 through 12, 14, 23 through 27 and 29 under 35 U.S.C. § 103.

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Groups H and I

Finally, we consider the rejection of claims 3 through 5, 8, 13, and 28 (Groups H and I) under 35 U.S.C. § 103 as being unpatentable over Honda in view of Sormunen and well known prior art. Claims 3 through 5, 8, 13, and 28 ultimately depend upon either independent claims 1 or 23. The examiner has not provided any evidence that the addition of well known prior art teaches the limitations of “putting together the information of the information requirements contained in the associated query profile” and “sending the information to the mobile telephone.” Accordingly, for

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the reasons addressed supra with respect to claims 1 and 23 we reverse the examiner's rejection of claims 3 through 5, 8, 13, and 28 (Groups H and I) under 35 U.S.C. § 103.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants [see 37 CFR § 1.192(a)]. Support for this rule has been demonstrated by our reviewing court in In re Berger 279 F3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the U.S. Court of Appeals for the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief, the issue is waived. Also see In re Watts 354 F.3d 1362, 13268, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In summary we affirm the examiner's rejection of claims 15, 16 and 20 under 35 U.S.C. § 102 and the examiner's rejection of claims 17, 18, 19, 21 and 22 under 35 U.S.C. § 103. We reverse the examiner's rejection of claims 1 through 14 and 23 through 29 under 35 U.S.C. § 103.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Affirmed in part.

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett
LEE E. BARRETT

LEE E. BARRETT
Administrative Patent Judge


ROBERT N. ANDERSON
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